REMARKS

In response to the final Office Action dated July 17, 2007, the Assignee respectfully requests continued examination and reconsideration based on the above amendments and on the following remarks.

Claims 1-6, 8, and 17-20 are pending in this application. Claims 7 and 9-16 have been canceled without prejudice or disclaimer.

Objection to Claims 17-20

The Office objected to claims 17-20 for reciting "time slot." Independent claim 17, however, has been amended and no longer contains the restricted language.

Rejection of Claims under 35 U.S.C. § 103 (a)

Claims 1-6, 8-9, 11-15, and 17-20 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent Application Publication 2002/0083441 to Flickinger, *et al.* in view of U.S. Patent 6,487,538 to Gupta, *et al.*

First, claims 9 and 11-15 have been canceled, so the rejection of these claims is moot.

Next, claims 1-6 and 17-20 cannot be obvious. These claims recite, or incorporate, many features that are not disclosed by the combined teaching of *Flickinger* and *Gupta*. Independent claim 1, for example, recites "*receiving programming content ... scheduled to be broadcasted in the future from a network provider's server to a subscriber's equipment*" (emphasis added). Support for such features may be found at least at page 7, lines 9-10 of the as-filed application. Independent claim 1 also recites "*determining, by the network provider's server, that the different advertisement has been recorded in a compatible format with the scheduled broadcast.*" Support for such features may be found at least at page 12, lines 1-2 of the as-filed application.

Independent claim 1 also recites "*searching, by the network provider, to determine a time of broadcast of a previous advertisement relating to a similar type of product as the different advertisement*" and "*when the previous advertisement was broadcast within two hours, then declining to replace the advertisement with the different advertisement.*" Support for such features may be found at least at page 11, lines 18-21 and at page 12, lines 1-7 of the as-filed application. Independent claim 1 also recites "*broadcasting the programming content to the subscriber's equipment, the broadcasted programming content having the advertisement replaced with the different advertisement.*" Support for such features may be found at least at page 5, lines 14-16, at page 7, lines 9-12, and at page 8, lines 14-15 of the as-filed application. Independent claim 1 is reproduced below, and independent claim 17 recites similar features.

1. An advertisement management method, comprising:

receiving programming content delivered as a scheduled lineup having an advertisement inserted into a future advertisement time slot, the programming content scheduled to be broadcasted in the future from a network provider's server to a subscriber's equipment;

categorizing, at the network provider's server, the advertisement as overrideable or non-overrideable, the overrideable categorization allowing the advertisement to be replaced with a different advertisement, and the non-overrideable categorization not allowing replacement of the advertisement and allowing the advertisement to be delivered as scheduled;

receiving, at the network provider's server, an advertiser's request to replace the advertisement with the different advertisement;

determining, at the network provider's server, whether the advertisement is categorized as overrideable;

determining, at the network provider's server, whether the advertisement and the different advertisement are nearly equal in time length;

determining, by the network provider's server, that the different advertisement has been recorded in a compatible format with the scheduled broadcast;

searching, by the network provider, to determine a time of broadcast of a previous advertisement relating to a similar type of product as the different advertisement;

when the previous advertisement was broadcast within two hours, then declining to replace the advertisement with the different advertisement;

> when the advertisement is categorized as overrideable, and when the advertisement and the different advertisement are nearly equal in time length, then replacing the advertisement with the different advertisement, such that the different advertisement is inserted into the programming content; and
>
> broadcasting the programming content to the subscriber's equipment, the broadcasted programming content having the advertisement replaced with the different advertisement.

Flickinger and *Gupta* cannot obviate all these features. *Flickinger* sends an "ad channel" to a subscriber's set top box (STB). U.S. Patent Application Publication 2002/0083441 to Flickinger, *et al.* at paragraphs [0012] and [0049]. The subscriber's STB selects ads from the ad channel that match the subscriber's demographic information. *See id.* at paragraphs [0055] and [0056]. When the subscriber tunes to a channel, that channel may contain "default ads, in which an alternate ad ... can be inserted ... (i.e., substituted for the default ad)." *Id.* at paragraph [0042]. An algorithm may compare a duration of an available advertisement slot to a duration of an advertisement. *See id.* at paragraph [0063]. *Gupta* discloses a proxy server that may replace an existing advertisement with another advertisement. *See* U.S. Patent 6,487,538 to Gupta, *et al.* at column 8, lines 45-50. The proxy server may collect a client computer's profile information and use this profile information to select advertisements. *See id.* at column 9, lines 10-20. The proxy server may replace an existing advertisement. *See id.* at column 11, lines 17-21. *See also id.* at column 13, lines 7-12. Replacement of an advertisement may be "restricted" by a web server. *Id.* at column 13, lines 48-50. An advertiser's server may negotiate pricing of ads. *See also id.* at column 13, lines 11-17.

Still, though, independent claims 1 and 17 cannot be obvious. The proposed combination of *Flickinger* and *Gupta* fails to teach or suggest "*determining, by the network provider's server, that the different advertisement has been recorded in a compatible format with the scheduled broadcast.*" The proposed combination of *Flickinger* and *Gupta* also fails to teach or suggest "*searching, by the network provider, to determine a time of broadcast of a previous advertisement relating to a similar type of product as the different advertisement*" and "*when the previous advertisement was broadcast within two hours, then declining to replace the*

advertisement with the different advertisement." Because *Flickinger* and *Gupta* are silent to at least these features, independent claims 1 and 17 cannot be obvious.

Flickinger and *Gupta*, then, cannot obviate claims 1-6 and 17-20. Independent claims 1 and 17 recite many features that are not taught or suggested by the proposed combination of *Flickinger* and *Gupta*. Dependent claims 2-6 and 18-20 incorporate these same features and recite additional features. One of ordinary skill in the art, then, would not think that claims 1-6 and 17-20 are obvious. The Office is thus respectfully requested to remove the § 103 (a) rejection of these claims.

***Flickinger* "Teaches Away"**

The proposed combination of *Flickinger* and *Gupta* "teaches away" from their combination. "A reference that 'teaches away' from the claimed invention is a significant factor" when determining obviousness. *See* M.P.E.P. at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. *See id.* at § 2141.02; *see also W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "It is improper to combine references where the references teach away from their combination." M.P.E.P. at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. *See* M.P.E.P. at § 2143.01.

The Office's *prima facie* case requires impermissible changes to *Flickinger's* principle of operation. As the above paragraphs explained, *Flickinger* sends an "ad channel" to a subscriber's set top box (STB). U.S. Patent Application Publication 2002/0083441 to Flickinger,*et al.* at paragraphs [0012] and [0049]. The subscriber's STB selects ads from the ad channel that match the subscriber's demographic information. *See id.* at paragraphs [0044], [0055], and [0056]. When the subscriber tunes to a channel, that channel may contain "default ads, in which an alternate ad ... can be inserted ... (i.e., substituted for the default ad)." *Id.* at paragraph [0042]. *Flickinger*, then, describes a set top box that stores advertisements and

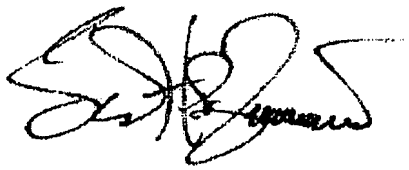
replaces a broadcasted "default ad" with a replacement advertisement stored in memory of the set top box. *See, e.g.*, paragraphs [0043] and [0044].

Flickinger's principle of operation, then, must be changed to support the *prima facie* case. Independent claims 1 and 17 similarly recite "*receiving programming content ... scheduled to be broadcasted in the future from a network provider's server to a subscriber's equipment*" (emphasis added). Independent claims 1 and 17 also recite "*categorizing, at the network provider's server, the advertisement as overrideable or non-overrideable*," "*receiving, at the network provider's server, an advertiser's request to replace the advertisement with the different advertisement*," and "*determining, at the network provider's server, whether the advertisement is categorized as overrideable*" (emphasis added). Independent claims 1 and 17 also recite "*broadcasting the programming content to the subscriber's equipment, the broadcasted programming content having the advertisement replaced with the different advertisement*" (emphasis added). Because *Flickinger's* principle of operation describes a set-top box that selects advertisements from an "ad channel," *Flickinger's* principle of operation must be changed to perform the claimed features "*at the network provider's server*," and to "*[broadcast] the programming content to the subscriber's equipment, the broadcasted programming content having the advertisement replaced with the different advertisement*" (emphasis added).

Flickinger, then, "teaches away" from the pending claims. *Flickinger's* principle of operation must be changed to support the *prima facie* case. The patent case law, however, prohibits changing a principle of operation to support a *prima facie* case. The proposed combination of *Flickinger* and *Gupta*, then, cannot support the § 103 rejection of the pending claims.

If any questions arise, the Office is requested to contact the undersigned at (919) 469-2629 or *scott@scottzimmerman.com*.

Respectfully submitted,



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